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10/577,610	09/25/2006	Simcha Gendelman	4529/97323	5371
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EXAMINER				
KANERVO, VIRPI H				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/577,610

Applicant(s)

GENDELMAN, SIMCHA

Examiner

VIRPI H. KANERVO

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-14, 16, 17, 19, 20 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-14, 16, 17, 19, 20 and 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. Claims 11-14, 16-17, 19-20, and 23-30, are presented for examination. Applicant filed an amendment on 06/22/2009 amending claims 11, 14, 17, and 19-20; canceling claims 1-10 and 21-22; and adding new claims 23-30. In light of Applicant's amendment, Examiner has withdrawn the grounds of the § 103 rejection. However, Examiner has established new grounds of § 103 rejection for claims 11-14, 16-17, 19-20, and 23-30, in the instant Office action. Since the new grounds of the § 103 rejection were necessitated by the Applicant's amendment of the claims, the rejection of claims 11-14, 16-17, 19-20, and 23-30, is a FINAL rejection of the claims.

Response to Arguments

2. Applicant, in the page 7 of the remarks/arguments, "disagrees with the Examiner's characterization of the processor of Nhaissi" arguing that "firstly, the bolded portions of the above quoted portion of the Office action do not appear in claim 11 as examined or as presently amended" and "secondly, neither Knox or Nhaissi show or suggest the following italicized features of claim 11 as presently

amended.” Since Examiner cannot detect any “bolded portions of the above quoted portion of the Office action,” nor any “italicized features of claim 11 as presently amended,” in Applicant’s remarks/arguments, the Applicant’s argument is moot.

3. Applicant argues that “in Nhaissi’s system the card number is NOT associated with the credit card account of the prepaid card issuer.”

First, the subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional, but does not require steps to be performed and/or does not limit a claim to a particular structure, does not limit the scope of a claim or claim limitation. The following is an example of language that may raise a question as to the limiting effect of the language in a claim: statements of intended use or field of use. See MPEP 3106 [R-6] II.C. Here, the language of claim 11 recites: “processor, operative using said prepaid card identification indicia to identify a credit card number associated with said credit card account of said prepaid card issuer.” “Processor, operative ... to identify” is a statement of intended use or field of use, and thus suggests or makes optional, but does not require steps to be performed and/or does not limit a claim to a particular structure. Therefore, it does not limit the scope of a claim or claim limitation.

Second, Nhaissi (2005/0203835 A1) specifically discloses that "when a credit card is used to connect to the Internet, a virtual pre-paid card is created (Nhaissi: page 17, ¶ 276), and that "there is no danger that user's credit card number will be stolen, since it need never be provided in the Internet" (Nhaissi: page 17, ¶ 276). Thus, Nhaissi shows "credit card number being different from said prepaid card identification indicia." Second, Knox (2002/0194122 A1) specifically discloses that "funds can be transferred into the customer's account using a credit card" (Knox: page 2, ¶ 19), and that "the credit card need not be the customer's credit card" (Knox: page 2, ¶ 19). Thus, the credit card can be a credit card of some other party, e.g., the credit card of the prepaid card issuer. Therefore, Knox in view of Nhaissi discloses "a credit card number associated with said credit card account of said prepaid card issuer, said credit card number being different from said prepaid card identification indicia."

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in § 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 11, 14, 20, and 23-25, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Knox (2002/0194122 A1) in view of Koppel (2002/0026418 A1), and further in view of Nhaissi (2005/0203835 A1).

As to claim 11, Knox shows an input device operative to receive prepaid card identification indicia from a prepaid card issued to a customer by a prepaid card issuer (Knox: page 2, ¶ 18; and Fig. 1, labels 105-106, and 110-111; note that this is statement of intended use or field of use); and a processor, operative using said prepaid card identification indicia to identify a credit card number associated with said credit card account of said prepaid card issuer (Knox: page 2, ¶ 19; note that this is statement of intended use or field of use).

Knox does not show said prepaid card issuer having a credit card account. Koppel show said prepaid card issuer having a credit card account (Koppel: page 2, ¶¶ 38-39). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox by said prepaid card issuer having a credit card account of Koppel in order to limit the losses due to fraud to the amount on the card (Knox: page 1, ¶ 11).

Knox in view of Koppel does not show said credit card number being different from said prepaid card identification indicia. Nhaissi shows said credit card number being different from said prepaid card identification indicia (Nhaissi: page 17, ¶ 276). It would have been obvious to one of ordinary skill in the art at

the time of the invention to have modified the system of Knox in view of Koppel by said credit card number being different from said prepaid card identification indicia of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

As to claim 14, Knox in view of Koppel, and further in view of Nhaissi, shows all the elements of claim 11. Knox also shows that said processor is operative to verify validity of said prepaid card identification indicia prior to processing a transaction (Knox: page 2, ¶ 18; note that this is statement of intended use or field of use).

As to claim 20, Knox in view of Koppel, and further in view of Nhaissi, shows all the elements of claim 11. Knox in view of Koppel does not show that said point of sale terminal receives, from a remote server, said credit card number associated with said credit card account of said prepaid card issuer. Nhaissi shows that said point of sale terminal receives, from a remote server, said credit card number associated with said credit card account of said prepaid card issuer (Nhaissi: page 17, ¶ 276). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Koppel by said point of sale terminal receiving, from a remote server, said credit card number associated with said credit card account of said prepaid card issuer of

Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

As to claim 23, Knox in view of Koppel, and further in view of Nhaissi, shows all the elements of claim 11. Knox in view of Koppel does not show that said point of sale terminal is operative to transmit information to a credit card transaction clearinghouse, said information including said credit card number associated with said credit card account. Nhaissi shows that said point of sale terminal is operative to transmit information to a credit card transaction clearinghouse, said information including said credit card number associated with said credit card account (Nhaissi: page 17, ¶ 276; note that this is statement of intended use or field of use). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Koppel by said point of sale terminal being operative to transmit information to a credit card transaction clearinghouse, said information including said credit card number associated with said credit card account of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

As to claim 24, Knox in view of Koppel, and further in view of Nhaissi, shows all the elements of claim 11. Knox also shows that said credit card account is associated with a plurality of said prepaid cards (Knox: page 1, ¶ 17; and page 2, ¶ 18).

As to claim 25, Knox in view of Koppel, and further in view of Nhaissi, shows all the elements of claim 11. Knox also shows that said processor is operative to enable said credit card identification indicia to be accessed at said point of sale terminal using said prepaid card identification indicia (Knox: Fig. 1, labels 105, 106, 110, and 111; note that this is statement of intended use or field of use).

Knox in view of Koppel does not show that said credit card identification indicia is the credit card number. Nhaissi shows that said credit card identification indicia is the credit card number (Nhaissi: page 17, ¶ 276). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Koppel by said credit card identification indicia being the credit card number of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

6. Claim 26 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Knox in view of Koppel, further in view of Nhaissi, and further in view of Maier (2003/0102376 A1).

As to claim 26, Knox in view of Koppel, and further in view of Nhaissi, shows all the elements of claim 11. Knox in view of Koppel does not show that said processor is operative to enable said credit card identifying indicia by accessing a lookup table based on said prepaid card identification indicia. Meier shows that

said processor is operative to enable said credit card identifying indicia by accessing a lookup table based on said prepaid card identification indicia (Meier: page 2, ¶ 29; note that this is statement of intended use or field of use). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Koppel by said processor being operative to enable said credit card identifying indicia by accessing a lookup table based on said prepaid card identification indicia of Meier in order to provide card identifier indicator (Meier: page 1, ¶ 8).

Knox in view of Koppel, and further in view of Meier, does not show that said credit card identification indicia is the credit card number. Nhaissi shows that said credit card identification indicia is the credit card number (Nhaissi: page 17, ¶ 276). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Koppel, and further in view of Meier, by said credit card identification indicia being the credit card number of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

7. Claims 12-13, 16-17, 19, 27-28, and 30, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Knox in view of Koppel, further in view of Nhaissi, and further in view of Wu (2003/0046249 A1).

As to claim 12, Knox in view of Koppel, and further in view of Nhaissi, shows all the elements of claim 11. Knox in view of Koppel, and further in view of Nhaissi, does not show that said input device is a card reader. Wu shows that said input device is a card reader (Wu: page 3, ¶ 34). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Koppel, and further in view of Nhaissi, by said input device being a card reader of Wu in order to provide means for reading the data contained on the prepaid card (Wu: page 3, ¶ 34).

As to claim 13, Knox in view of Koppel, and further in view of Nhaissi, shows all the elements of claim 11. Knox in view of Koppel, and further in view of Nhaissi, does not show that said input device is a keyboard. Wu shows that said input device is a keyboard (Wu: page 3, ¶ 34). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Koppel, and further in view of Nhaissi, by said input device being a keyboard of Wu in order to permit the customer to input information concerning the purchase of the prepaid card (Wu: page 3, ¶ 34).

As to claim 16, Knox in view of Koppel, and further in view of Nhaissi, shows all the elements of claim 11. Knox in view of Koppel, and further in view of Nhaissi, does not show a communicator, operative to communicate said prepaid card

identification indicia to a remote server to determine validity of said prepaid card. Wu shows a communicator, operative to communicate said prepaid card identification indicia to a remote server to determine validity of said prepaid card (Wu: page 3, ¶ 34; note that this is statement of intended use or field of use). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Koppel, and further in view of Nhaissi, by a communicator, operative to communicate said prepaid card identification indicia to a remote server to determine validity of said prepaid card of Wu in order to permit the network interface device of the terminal to communicate and connect with authorized remote servers located on the global communications network such as Internet (Wu: page 3, ¶ 34).

As to claim 17, Knox in view of Koppel, further in view of Nhaissi, and further in view of Wu, shows all the elements of claim 16. Knox in view of Koppel, and further in view of Nhaissi, does not show that said remote server is operative to communicate information regarding a balance remaining on said prepaid card, via said communicator, to said terminal. Wu shows that said remote server is operative to communicate information regarding a balance remaining on said prepaid card, via said communicator, to said terminal (Wu: Fig. 2; and page 4, ¶¶ 40-41; note that this is statement of intended use or field of use). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Koppel, further in view of Nhaissi, by said

remote server being operative to communicate information regarding a balance remaining on said prepaid card, via said communicator, to said terminal of Wu in order to permit the network interface device of the terminal to communicate and connect with authorized remote servers located on the global communications network such as Internet (Wu: page 3, ¶ 34).

As to claim 19, Knox in view of Koppel, and further in view of Nhaissi, shows all the elements of claim 11. Knox in view of Koppel does not show a storage device for storing said credit card identification indicia associated with said credit card account of said prepaid card issuer. Wu shows a storage device for storing said credit card identification indicia associated with said credit card account of said prepaid card issuer (Wu: page 3, ¶ 34; note that this is statement of intended use or field of use). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Koppel by a storage device for storing said credit card identification indicia associated with said credit card account of said prepaid card issuer of Wu in order to permit the network interface device of the terminal to communicate and connect with authorized remote servers located on the global communications network such as Internet (Wu: page 3, ¶ 34).

Knox in view of Koppel, and further in view of Wu, does not show that said credit card identification indicia is the credit card number. Nhaissi shows that said credit card identification indicia is the credit card number (Nhaissi: page 17, ¶

276). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Koppel, and further in view of Wu, by said credit card identification indicia being the credit card number of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

As to claim 27, Knox in view of Koppel, further in view of Nhaissi, and further in view of Wu, shows all the elements of claim 16. Knox also shows that said credit card identification indicia is stored at said remote server (Knox: Fig. 1, labels 110, 111, and 150; and page 2, ¶ 18).

Knox in view of Koppel, and further in view of Wu, does not show that said credit card identification indicia is the credit card number. Nhaissi shows that said credit card identification indicia is the credit card number (Nhaissi: page 17, ¶ 276). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Koppel, and further in view of Wu, by said credit card identification indicia being the credit card number of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

As to claim 28, Knox in view of Koppel, further in view of Nhaissi, and further in view of Wu, shows all the elements of claim 16. Knox also shows that said credit

card identification indicia is accessed at said remote server using said prepaid card identification indicia (Knox: Fig. 1, labels 110, 111, 150; and page 2, ¶ 18).

Knox in view of Koppel, and further in view of Wu, does not show that said credit card identification indicia is the credit card number. Nhaissi shows that said credit card identification indicia is the credit card number (Nhaissi: page 17, ¶ 276). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Koppel, and further in view of Wu, by said credit card identification indicia being the credit card number of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

As to claim 30, Knox in view of Koppel, further in view of Nhaissi, and further in view of Wu, shows all the elements of claim 16. Knox also shows that said validity of said prepaid card relates to balance information (Knox: page 2, ¶ 18).

8. Claim 29 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Knox in view of Koppel, further in view of Nhaissi, further in view of Wu, and further in view of Maier.

As to claim 29, Knox in view of Koppel, further in view of Nhaissi, and further in view of Wu, shows all the elements of claim 16. Knox in view of Koppel, and further in view of Wu, does not show that said processor is operative to identify

said credit card identification indicia by sending said prepaid card identification indicia to a remote server which includes a lookup table. Meier shows that said processor is operative to identify said credit card identification indicia by sending said prepaid card identification indicia to a remote server which includes a lookup table (Meier: page 2, ¶ 29; note that this is statement of intended use or field of use). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox by said processor being operative to identify said credit card identification indicia by sending said prepaid card identification indicia to a remote server which includes a lookup table of Meier in order to provide card identifier indicator (Meier: page 1, ¶ 8).

Knox in view of Koppel, further in view of Nhaissi, and further in view of Wu, does not show that said credit card identification indicia is the credit card number. Nhaissi shows that said credit card identification indicia is the credit card number (Nhaissi: page 17, ¶ 276). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Koppel, further in view of Nhaissi, and further in view of Wu, in view of Meier by said credit card identification indicia being the credit card number of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Horgan (2002/0022966 A1) discloses method and system for ubiquitous enablement of electronic currency.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VIRPI H. KANERVO whose telephone number is

571-272-9818. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m., EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Virpi H. Kanervo

/Alexander Kalinowski/

Supervisory Patent Examiner, Art Unit 3691